UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,740	04/13/2001	Daniel J. Drucker	016777-0463	2882

7590 10/29/2003

Stephen A. Bent
FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, DC 20007-5109

EXAMINER	
PRIEBE, SCOTT DAVID	
ART UNIT	**PAPER NUMBER**
1632	

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/833,740	DRUCKER ET AL.	
	Examiner	Art Unit	
	Scott D. Priebe	1632	

--The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

THE REPLY FILED 09 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☒ A Notice of Appeal was filed on *09 October 2003*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☒ The proposed amendment(s) will not be entered because:

(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☒ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: *See Continuation Sheet*.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: *none*.

Claim(s) objected to: *none*.

Claim(s) rejected: *1-5 and 9-11*.

Claim(s) withdrawn from consideration: *6-8*.

8.☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

Scott D. Priebe
Primary Examiner
Art Unit: 1632

Continuation of 2. NOTE: The proposed amendment to para. 0020 introduces new matter Appellant persists in attempting to tie Figures 3 and 4 together when the specification does not support the connection. Proposed claim 1 inaccurately represents the support in the specification; the claim should read (line 4) "transcription start site 5' of the untranslated region of the GLP-2R gene". Proposed claim 9 recites "Sequence ID NO HS17 10875". It is unclear what this refers to, which raises the issue of new matter, and it does not provide the SEQ ID NO assigned to the sequence in the Sequence Listing. Proposed claim 12 contains new matter, paras. 43 and 77 do not support the inclusion of (ii) as part of the promoter region. Para. 43 clearly teaches that the promoter region begins 5' to the 5' UTR and extends upstream. Para. 77 clearly teaches that the 126 bp sequence etc. is part of the cDNA, i.e. it includes the 5' UTR. Also, neither para. mentions a "first and second promoter" or linkage.

Continuation of 5. does NOT place the application in condition for allowance because: the arguments depend in large part upon the proposed amendments, which have not been entered. No rejection was made for lack of enablement. With respect to written description, etc., the claims are directed to "a promoter region" of a mammalian GLP-2R gene. The claims require at least 1000 nucleotides of genomic sequence upstream of the transcription start site, i.e. upstream of the 5' UTR. The specification fails to disclose 1000 nucleotides of genomic sequence upstream of the transcription start site of any GLP-2R gene, including mouse. SEQ ID NO: 1 includes only about 800 nucleotides upstream of the transcription start site. In addition, para. 43 clearly indicates that the complete promoter region, i.e. containing all regulatory sequences involved in expression of the endogenous GLP-2R gene, may extend beyond 8,000 nucleotides upstream of the transcription start site. The degree of homology between the rat, mouse and human 5' UTR sequences is irrelevant, since the promoter region, as defined, begins 5' of the UTR and extends upstream. The specification provides no sequence information for the rat promoter region, the sequence information begins with the 5' UTR and extends downstream (Fig. 7b). Only about 200 nucleotides of the human sequence are provided, and the specification clearly indicates that the 5' flanking sequences of mouse and human diverge significantly more than 200 nucleotides upstream of the 5'UTR. Consequently, the mouse sequences upstream of the this conserved region do not allow one to envision the corresponding sequence from any other mammal. In essence, Applicant is attempting to overreach the disclosure of part of the promoter regions of the mouse and human GLP-2R promoter to lay claim to the entire region, and the entire promoter regions of other mammals for which no information is presented.